

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: R. Mancho

Art Unit: 3661

In re:

Applicant: KUSCHKE

Serial No.: 09/095,397

Filed: June 01, 1998

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SEP 25 2001

OFFICE OF PETITIONS

AMENDMENT

September 10, 2001

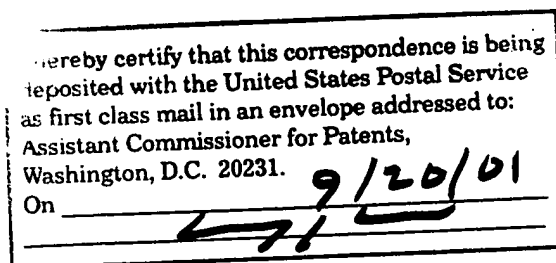
Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

This communication is responsive to the last Office Action.

OK to enter
R.m

11-19-01



In the Office Action the Examiner rejected the claims over the patent to Kaneshige . In the Examiner's opinion the present invention can be considered as disclosed in the reference. It is believed that the Examiner's opinion about the disclosure of the patent to Kaneshige is not completely justified, since in the applicants' opinion the patent to Kaneshige does not teach the features of the present invention. Applicants agree with the Examiner that the patent to Kaneshige discloses a screening housing for microwave circuits, which has a housing body having an interior, said housing body open at least at one side thereof; a substrate (shielded inside 12) mounted on an inner side of said cover (casing 11) and means forming a plurality of chambers provided for accommodating of individual circuit units (high frequency oscillator 17), so that said individual circuit units are screened from one another; said means including said substrate (12) on said inner side of said cover 11 and a plurality of webs (walls 13).

Admission

The patent to Kaneshige does not explicitly show the structure of the casing in a cross-section. Instead, its structure is described in column 4, lines 1-6, in particular in lines 4-6:

“the shielding of the inside 12 and the walls 13 is effected by respectively plating the inside end walls of the casing with nickel, copper or other suitable material”.

It is believed to be clear that this phrase implies the inside 12 of the casings and the walls 13 to exist before the shielding is formed. Since the casing of this type are usually molded in one piece, any skilled person in the art who familiarize himself with this teaching will assume that the walls 13 are formed in one piece together with the rest of the casing 11, and that the shielding is applied to both afterwards. However, it is only possible to form the webs/walls directly on the substrate/shielding claimed in the present application, if the substrate/shielding is there first and the walls/webs are formed after the shielding or at least simultaneously with it. The patent to Kaneshige certainly does not have any hint or suggestion to proceed in this way.

It is therefore believed to be clear that the new features of present invention which are defined in claim 1 are not disclosed in this reference and can not be derived from it as a matter of obviousness.

In applicant's opinion in order to demonstrate that Kaneshige suggests the features of claim 1 the Examiner will have to provide a prior art that teaches a screening housing in which a screening layer or substrate is formed before the webs, or at least simultaneously with them. However, no such prior art have been cited or applied against the present application. Accordingly, unless there is no proof to the contrary, it must be assumed that the possibility of forming screening webs directly on the screening substrate of a housing was not known to a skilled person before the present invention.

It is believed to be clear that the reference applied by the Examiner does not disclose the main features of the present invention. Also, it does not provide any hint or suggestion that such features can be or must be provided in the reference. In order to arrive at the applicant's invention from the reference, the reference has to be fundamentally modified by including into it the features which are first proposed by applicant. It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the reference does not contain any hint or suggestion for such modifications.

In view of the above presented remarks and amendments, it is believed that claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

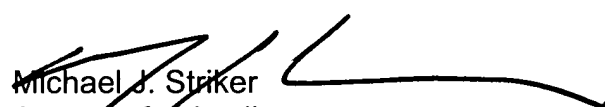
As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue.

Any costs involved should be charged to the deposit account of the undersigned (No. 19-4675). Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
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Reg. No. 27233

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